

REMARKS/ARGUMENTS

Upon entry of the amendments, claims 1 and 3-7 will be pending in the application.

Applicants note that a new non-final Office Action has been issued. The anticipation rejections have been withdrawn and the Examiner has issued new obviousness rejections. Reconsideration of the Office Action is respectfully requested.

Claim Amendments

Claim 1 has been amended to include the features of claim 2 and the subject matter set forth on page 2, line 10 of the specification. No new matter has been introduced and no claim fees are believed to be due.

Claim Rejections-35 U.S.C. § 103

The rejection of Claims 1-7 under 35 U.S.C. § 103(a), as obvious based upon *Hartmann* (US 5,959,005) in view of *Gonzalez-Oliver* (US 5,063,003), *Kayanoki* (US 5,654,090), *Kirtley* (US 5,719,220), or *Mizoguchi* (US 6,017,971), is traversed and reconsideration is respectfully requested.

Applicants respectfully assert that a *prima facie* case of obviousness has not been established. To support a proper obviousness rejection, three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination

and the reasonable expectation of success must both be found in the prior art and not based on Applicants' disclosure.

Hartmann (which is assigned to the assignee of the present application) discloses a method of producing a surface modified, hydrophobic silanized silica powder by modifying the surface with hexamethyldisilazane (HMDS). The surface modified silica according to Hartmann is a low thickening silanized silica, which shows high degrees of filling and therewith good mechanical strengths by means of its low thickening action and low flow point (see column 2, lines 3 to 8).

The Office Action acknowledges that *Hartmann* fails to teach or suggest the 3-methacryloxypropylsilyl and/or glycidyloxypropylsilyl functional groups that are features of the independent claims. To overcome this failing, the secondary references are relied upon in the Office Action. The secondary references respectively relate to objects of silica glass, a coating composition, molded composites, and a resin composition to be plated.

Applicants agree that *Hartmann* fails to provide any teachings, hints, or suggestions regarding surface modifying agents like 3-methacryloxypropyltrialkoxysilane and/or glycidyloxypropyltrialkoxysilane. Further, Applicants dispute that the cited references teach, hint, or suggest pyrogenically produced silica as set forth in the independent claims.

Applicants also assert that the secondary references are not relevant in determining a *prima facie* case of obviousness. The claimed silica would not be suggested to a person skilled in the art by modifying the primary reference, which is directed toward filling silica, with teachings relating to silica glass (*Gonzalez-Oliver*), coating composition (*Kayanoki*), molded composites (*Kirtley*), or a resin composition to be plated (*Mizoguchi*). Just because individual parts of the claimed invention may be found in the prior art is not by itself significant.

Hypothetically, even if the references relied upon teach that all aspects of the claimed invention were individually known in the art , it would not establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. This objective reason can not be based upon Applicants' disclosure and must be found in the references. The Office Action lacks any reasoning as to why a person skilled in the art would find motivation in the cited references to perform the proposed modification of the silica filling material of Hartmann.

Applicants also assert that a person skilled in the art would not attempt to utilize the *Hartmann* silica for coating compositions (as set forth in claim 5) because there would not be a reasonable expectation of success because the Hartmann silica has a high degree of viscosity. The silica of *Hartmann* is the same as the Aerosil R 8200, which is discussed in the specification. Therefore, there would not be sufficient motivation to modify the filling silica of *Hartmann* with the teachings of the secondary references (even if one of the secondary references, Kayanoki, relates to coatings) because of the physical characteristics of the *Hartmann* silica, which is modified by HMDS.

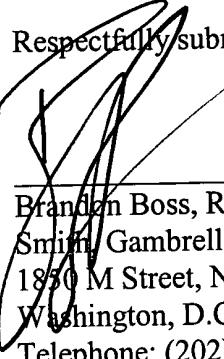
CONCLUSION

Applicants respectfully await allowance of the application. If any additional fees are due in connection with the filing of this response, please charge the fees to Deposit Account No. 02-4300. Any overpayment can be credited to Deposit Account No. 02-4300.

Date: July 9, 2004

Signature:

Respectfully submitted,


Brandon Boss, Reg. No. 46,567*
Smith, Gambrell & Russell, L.L.P.
1850 M Street, N.W., Suite 800
Washington, D.C. 20036
Telephone: (202) 263-4300

* Practice is limited to matters and proceeding before federal courts and agencies.